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Confirmation No. 3589

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Wollenberg et al. Examiner: M. Wallenhorst
Serial No.: 10/699,508 Group: Art Unit 1743
Filing Date: October 31, 2003 Docket: T-6298C (538-62)
For: HIGH THROUGHPUT SCREENING Dated: July 26, 2006
METHODS FOR LUBRICATING OIL
COMPOSITIONS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Sir:

In response to the Examiner's Answer mailed June 1, 2006, Appellants respectfully submit that based on at least the arguments provided in the Appeal Brief of May 5, 2006, appealed Claims 1-23 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, Alexandria, VA 22313-1450, Mail Stop Appeal Brief-Patents on July 26, 2006.

Dated: July 26, 2006


Michael E. Carmen

First, with respect to the statement regarding appealed Claims 1-6, 10 and 15-19 in the paragraph on page 14 of the Examiner's Answer that "Based upon the combination of Kolosov et al. and O'Rear, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to screen the lubricant/additive compositions in the combinatorial array taught by Kolosov et al. for oxidation stability since Kolosov et al. teach that the plurality of samples in the array are screened for various material characteristics like thermal degradation, chemical composition, etc., and O'Rear teaches that it is common to screen lubricating oil compositions for their oxidation stability by determining the time required for a lubricant sample to consume a predetermined amount of oxygen.", Appellants respectfully disagree. The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case. See *In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). There must be some basis in the references for concluding that the claimed subject matter would have been obvious.

Contrary to the Examiner's statement, Kolosov et al. merely disclose that the system or method disclosed therein may be used to screen or test most any flowable material that may be a commercial product itself or may be an ingredient or portion within a commercial product, e.g., a thermal degradation test. Thermal degradation tests however can be used for many different applications, e.g., polymers to determine flame retardancy, foods, etc. O'Rear simply discloses a non-automatic means to measure the oxidation properties of lubricating oil compositions. Thus, nothing in O'Rear would lead one skilled in the art to modify the method of Kolosov et al. and arrive at the automatic high throughput method for screening lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, as set forth in the presently appealed claims, by measuring the oxidation stability of each sample to provide oxidation stability data for each sample; and, outputting the results such that a diverse number of lubricating oil additives can be rapidly analyzed and screened. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention.


Second, with respect to the statement regarding appealed Claims 1-6, 10 and 15-19 in the paragraph on page 15 of the Examiner's Answer that "Based upon the combination of Kolosov et al. and Gatto, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to screen the lubricant/additive compositions in the combinatorial array taught by Kolosov et al. for oxidation stability since Kolosov et al. teach that the plurality of samples in the array are screened for various material characteristics like thermal degradation, chemical composition, etc., and Gatto teaches that it is common to screen lubricating oil compositions for their oxidation stability by measuring the amount required of deposits formed by a lubricant sample exposed to oxidation reaction conditions.", Appellants respectfully disagree. The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case. See *In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). There must be some basis in the references for concluding that the claimed subject matter would have been obvious.

Contrary to the Examiner's statement, Kolosov et al. merely disclose that the system or method disclosed therein may be used to screen or test most any flowable material that may be a commercial product itself or may be an ingredient or portion within a commercial product, e.g., a thermal degradation test. Thermal degradation tests however can be used for many different applications, e.g., polymers to determine flame retardancy, foods, etc. Gatto discloses testing organomolybdenum compositions useful as lubricant additives in a base oil using the Caterpillar Micro-Oxidation test. Thus, nothing in Gatto would lead one skilled in the art to modify the method of Kolosov et al. and arrive at the automatic high throughput method for screening lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, as set forth in the presently appealed claims, by measuring the oxidation stability of each sample to provide oxidation stability data for each sample; and, outputting the results such that a diverse number of lubricating oil additives can be rapidly analyzed and screened. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention.

The Examiner has failed to show that all of the recitations of appealed Claims 1 and 15 are taught or suggested by the prior art. Accordingly, the Examiner has failed to make out a *prima facie* case for an obviousness rejection. Appealed Claims 1-6, 10 and 15-19 are therefore not rendered unpatentable by Kolosov et al. in view of O'Rear or Gatto. Thus, appealed Claims 1-6, 10 and 15-19 are allowable.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §§1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-3591. **TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.**

Dated: July 26, 2006

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